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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/060,501 | 01/30/2002 | Dennis W. Janes | 85939.000217 | 8924 |

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| EXAMINER | |
|---|---|
| KRUER, KEVIN R | |
| ART UNIT | PAPER NUMBER |
| 1773 | |

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Applicati n N . | Applicant(s) | |
|---|---|---|---|
| | 10/060,501 | JANES ET AL. | |
| | Examiner | Art Unit | |
| | Kevin R Kruer | 1773 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *05 March 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *37-83* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *37-83* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 37, 39, 42-45, 47-50, 52-54, 56-60, 62-68, 70-72, and 74-83 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-30 of prior U.S. Patent No. 6,406,785. This is a double patenting rejection. The claims appear to be exact duplicates of the parent application.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 38, 40, 46, and 55 are rejected under the judicially created doctrine of double patenting over claims 2, 4, 6, and 9 respectively of U. S. Patent No. 6,406,785.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons stated in Paragraph #5 of Paper #3.

***Claim Rejections - 35 USC § 112***

5. The rejection of claims 41, 51, 52, 61, and 69 under 35 U.S.C. 112, first paragraph, has been withdrawn. The claims are supported by originally filed claims 5 and 15.

6. The rejection of claims 39, 40, 41, 48, 52, 58, and 66 are rejected under 35 U.S.C. 112, second paragraph, has been overcome by amendment.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 37-72 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chihara et al (US 5,115,007) in view of Kamei (US 5,716,573) Ohdaira et al (US 4,670,508), and Kato et al (US 5,447,671). Chihara teaches a weatherstrip for automobile window glass run channels in which an EPDM substrate is coated with a low friction, abrasion resistant coating composition (col 1, lines 12-19). The coating composition comprises a thermosetting polymeric binder derived from a blocked polyurethane prepolymer solution which is compounded with silicone oil and a crosslinking agent. Additionally, compounding additives such as micropowders or polyethylene may be included in the coating composition (col 6, lines 57-67). The

weatherstrips are formed by first mixing the individual components of the coating, applying the mixture to EPDM glass run channel, and then curing the coating by heat (col 10, lines 60-64).

Chihara et al does not specifically disclose that the polyethylene used as the micropowder additives are high molecular weight particles. However, Kamei discloses a weather strip which has been surface treated with a sliding plane film comprising thermoplastic resin powder grains embedded in a thermoplastic base resin (col 3, lines 51-54). Kamei discloses that it is possible to obtain a sliding plane of low sliding resistance and superior wear resistance by a high sliding property of UHMW polyethylene. Consequently, in light of what Kamei discloses, one of ordinary skill in the art would have found it obvious to use UHMW polyethylene as the material for the polyethylene micropowders to be incorporated in the coating composition of Chihara et al. The motivation for doing so would have been to improve the sliding property and wear resistance of the coating composition.

Neither Chihara et al nor Kamei disclose that the polyethylene particles are surface treated or that they contain polar chemical groups that can be chemically bonded to thermoset carrier. However, surface modification of UHMW polyethylene powder to include at least one polar group is known in the art. For example, Ohdaira et al discloses UHMW particles which are surface treated in such a manner in order to provide better affinity to the thermoplastic resin matrix in which they are embedded (col 4, lines 27-39). One of ordinary skill in the art would have found it obvious to treat the surface of the UHMW particles by introducing polar functional groups. The motivation

for doing so would have been to improve the affinity of the particles to the thermoset polyurethane matrix.

One of ordinary skill in the art would have found it obvious to ensure that the UHMW particles do not melt during production of the coating composition by optimizing the melting temperature of the particles to above the curing temperature of the thermoset polyurethane matrix. The motivation for doing so would have been to ensure that the identity and properties of the individual UHMW polyethylene particles are not affected.

Chihara et al does not specifically disclose that the particles form surface projections in the low friction coating composition. However, the reference does disclose that the micropowders may be added on a weight basis, from about 5 to 60 parts per 100 parts by weight of organic coating components (col 6, lines 67-68 to col 7, line 1). It is the examiner's position that if the micropowders are uniformly distributed in the composition in the maximum amount (60 parts by weight), at least some of the particles will be present on the coating surface and cause surface projections. Furthermore, Kato et al discloses window glass edging members which are provided with a rough contacting layer that has many projections and recesses formed thereon by the presence of particles (abstract; col 2, lines 62-64). These particles can be made of UHMW polyolefin resins (col 6, lines 10-17). According to Kato, the rough surfaces permit the window glass to be opened and closed with much less sliding resistance (col 4, lines 3-5). One of ordinary skill in the art would therefore have found it obvious to include surface projections in the coating composition disclosed by Chihara et al. The

motivation for doing so would have been to reduce the sliding resistance when the glass window is opened and closed.

9. Claims 73, 74, and 76-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chihara et al (US 5,115,007) in view of Kamei (US 5,716,573) Ohdaira et al (US 4,670,508), and Kato et al (US 5,447,671), as applied to claims above, and further in view of Hazelton et al (US 4,894,408). Chihara in view of Kamei, Ohdaira, and Kato is relied upon as above. None of the references teach that the substrate of Chihara may comprise thermoplastic elastomers. However, Hazelton teaches a thermoplastic elastomer composition (abstract) that is useful in weatherstripping applications which require retention of sealing capability in dynamic situations (col 13, lines 40+). Thus, it would have been obvious to one of ordinary skill in the art to utilize the thermoplastic elastomer taught in Hazelton as the substrate taught in Chihara because the thermoplastic elastomer retains sealing capability in dynamic situations.

***Response to Arguments***

Applicant's arguments with respect to claims 37-73 have been considered but are moot in view of the new ground(s) of rejection. However, the examiner would like to respond to some of applicant's arguments that may be relevant to the new rejections.

Applicant argues that the claims of the current application are not substantial duplicates of claims 1-30 in US 6,406,785. In support of this position, Applicant has submitted a Certificate of Corrections that shows claims 1-30 are drawn to crosslinked particles. The examiner finds applicant's arguments unconvincing because the Office

has not accepted the Certificate of Corrections. Thus, the patented claims of US6.406,785 are the claims that were originally published.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday from 7:00a.m. to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

K-RK

krk

Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700